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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,102	01/14/2004	Sachin Govind Deshpande	10237.28	2922
65400 7590 07/21/2008 KIRTON & MCCONKIE 1800 EAGLE GATE TOWER / 60 EAST SOUTH TEMPLE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120				
EXAMINER NAJEE-ULLAH, TARIQ S				
ART UNIT 2152		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/757,102

Applicant(s)

DESHPANDE, SACHIN GOVIND

Examiner

TARIQ S. NAJEE-ULLAH

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 23, 2008 has been entered.

Response to Amendment

2. The affidavit filed on May 23, 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kotzin, US 2005/0090242 reference.

3. **37 CFR 1.131 (b)** stated that:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

4. **MPEP 715.02** further stated that:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it.

5. **MPEP 715.07** stated that:

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d). A general

Art Unit: 2152

allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

6. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Kotzin reference to either a constructive reduction to practice or an actual reduction to practice. No evidence is provided to establish the diligence from the date of conception to the a date prior to the date of reduction to practice of the Kotzin reference. In addition, no evidence of conception is provided to support the applicant's statement of the date of conception as early as August 13, 2003. Hence, applicant's diligence from the date of August 13, 2003 to the date of conception of the Kotzin reference is not shown. Applicant has not met the burden of showing prior invention.

7. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Kotzin reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by

a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). No evidence is provided to show prior conception. For this reason, there is insufficient evidence to show prior conception of all of the claimed limitation (see MPEP 715.02 and 715.07 cited above). Applicant has not met the burden of showing prior invention.

Response to Arguments

8. Regarding the rejection of claims 1-29 under USC 103 (a), Applicant argues that Kotzin, US 2005/0090242, does not qualify as prior art. Applicant's arguments filed on May 23, 2008 regarding Kotzin have been fully considered but they are not persuasive. The affidavit filed on May 23, 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kotzin reference. Examiner maintains use of Kotzin as prior art.
9. In view of the amendments to claims 20-29 and the specification, the rejection of claims 20-29 under 35 U. S. C. 101 is withdrawn.
10. Applicant's arguments filed May 23, 2008, with respect to the rejection(s) of claim(s) 2, 11, 14, 21 and 29 under 35 USC 103(a) as being unpatentable over Kakivaya-Kotzin (the combination of US Patent Application Publication 2004/0267876 to Kakivaya et al in view of US Patent Application Publication 2005/0090242 to Kotzin et al under 35 USC 103(a)), as applied to claims 1, 10, 13, 20 and 28, and further in view of Peters 6,601,093 (Peters hereinafter), have been fully considered and are persuasive.

Examiner acknowledges that Peters does not teach "request is further made using a randomized exponential backoff strategy" prior to a connection being made. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made under 35 USC 103(a) as being unpatentable over Kakivaya-Kotzin in view of Fantaske 2002/0045435 (Fantaske hereinafter).

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 2, 11, 14, 21, and 29 are rejected under 35 USC 103(a) as being unpatentable over Kakivaya-Kotzin, as applied to claims 1, 10, 13, 20 and 28 restated below, and further in view of Fantaske 2002/0045435 (Fantaske hereinafter).

Regarding claims 2, 11, 14, 21, and 29, Kakivaya-Kotzin discloses the invention substantially as described in claims 1, 10, 13, 20, and 28 restated below. Kakivaya-Kotzin does not teach **using a randomized exponential backoff strategy**.

Fantaske teaches **using a randomized exponential backoff strategy** (Fantaske, pg. 3-4, par. [0037]; randomly selected exponential backoff interval prior to connection being established). Kakivaya-Kotzin and Fantaske are analogous art because they are from the same field of endeavor of network communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Fantaske exponential random-backoff delay with Kakivaya's discovery protocol and Kotzin's establishing a common link with a second device after discovery

acknowledgement. The suggestion/motivation would have been to determine whether the access point is communicating with another wireless terminal (Fantaske, pg. 3-4, par. [0037]).

13. Examiner maintains all other claim rejections of claims 1, 3-10, 12-13, 15-20 and 22-28 under USC 103(a) presented in the previous office action mailed March 3, 2008. A restatement of those claim rejections that considers Applicant's amendments to claims 20-29 follows below.

14. Claims 1, 3-6, 12-13, 15-19, 20, and 22-24 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent Application Publication 2004/0267876 to Kakivaya et al (Kakivaya hereinafter) further in view of US Patent Application Publication 2005/0090242 to Kotzin et al (Kotzin hereinafter).

Regarding claim 1, Kakivaya teaches **initiating a request at the client to discover the server** (Kakivaya, Pg. 1, par. [0005]), **wherein the request is made using a multicast procedure** (Kakivaya, Pg. 1, par. [0005]); **receiving a response to the request from the server after a random delay time** (Kakivaya, Pg. 9, par. [0199-0200]; find response is sent after random delay time.). Kakivaya does not teach **establishing a connection with the server after receiving the response.**

Kotzin teaches **establishing a connection with the server after receiving the response** (Kotzin, Pg. 5, par. [0040]). Kakivaya and Kotzin are analogous art because they are from the same field of endeavor of network communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use

Kotzin's establishing a common link with a second device after discovery acknowledgement with Kakivaya's discovery protocol. The suggestion/motivation would have been to establish two way communication between devices (Kotzin, pg. 1, par. [0002]).

Regarding claim 13, Kakivaya teaches **server coupled to a network** (Kakivaya, fig. 1); **and a client coupled to the network** (Kakivaya, fig. 1), **wherein the client is configured to selectively provide a request on the network to discover the server** (Kakivaya, Pg. 1, par. [0005]), **wherein the client is configured to selectively provide programming content to a viewer** (Kakivaya, pg. 13, par. [0302]), **and wherein the request is a multicast procedure** (Kakivaya, Pg. 1, par. [0005]). Kakivaya does not teach **selectively establish a connection with the server after receiving a response to the request from the server.**

Kotzin teaches **selectively establish a connection with the server after receiving a response to the request from the server** (Kotzin, Pg. 5, par. [0040]). Kakivaya and Kotzin are analogous art because they are from the same field of endeavor of network communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Kotzin's establishing a common link with a second device after discovery acknowledgement with Kakivaya's discovery protocol. The suggestion/motivation would have been to establish two way communication between devices (Kotzin, pg. 1, par. [0002]).

Regarding claim 20, Kakivaya teaches **a computer readable medium storing a computer program product for implementing within a computer system a method for discovering and connecting to a server on the networked system, the computer program code means comprised of executable code for** (Kakivaya, Pg. 13, par. [0300]): **initiating a request at a client to discover a server** (Kakivaya, Pg. 1, par. [0005]), **wherein the request is made using a multicast procedure** (Kakivaya, Pg. 1, par. [0005]); **receiving a response to the request from the server after a random delay time** (Pg. 9, par. [0199-0200]). Kakivaya does not teach **establishing a connection with the server after receiving the response.**

Kotzin teaches **establishing a connection with the server after receiving the response** (Kotzin, Pg. 5, par. [0040]). Kakivaya and Kotzin are analogous art because they are from the same field of endeavor of network communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Kotzin's establishing a common link with a second device after discovery acknowledgement with Kakivaya's discovery protocol. The suggestion/motivation would have been to establish two way communication between devices (Kotzin, pg. 1, par. [0002]).

Regarding claims 3 and 16, Kakivaya-Kotzin disclose the invention substantially as described in claims 1 and 13 above, including **wherein the response includes information about a server IP address and TCP port where the client can make the connection with the server** (Kakivaya, Pg. 3, par. [0042]).

Regarding claims 4-5, 17-18, and 22-23, Kakivaya-Kotzin discloses the invention substantially as described in claims 1, 13, and 20 above, including **wherein the client is a television that is configured to provide programming content** (Kakivaya, pg. 2, par. [0034]) and **the server is a computer device** (Kakivaya, pg. 2, par. [0034]).

Regarding claims 6 and 24, Kakivaya-Kotzin discloses the invention substantially as described in claims 1 and 20 above, including receiving **a second response to the request from a second server after the random delay time** (Kakivaya, pg. 10, par. [0223] teaches sending multiple responses to a discovery request, pg. 3, par. [0037]; teaches multiple servers, i.e. first, second server, etc.).

Regarding claims 12 and 19, Kakivaya-Kotzin discloses the invention substantially as described in claims 1 and 13 above, including wherein **the request includes a random identifier that is repeated in the response** (Kakivaya, pg. 1, par. [006-007]; teaches a unique identifier, i.e. random identifier).

Regarding claim 15 Kakivaya-Kotzin discloses the invention substantially as described in claim 13 above, including **wherein the network is a home network** (Kakivaya, pg. 2, par. [0033]).

15. Claims 10 and 28 are rejected under 35 USC 103(a) as being unpatentable over Kakivaya-Kotzin, as applied to claims 1 and 20 above, and further in view of Harvey et al 2004/0054807 (Harvey hereinafter).

Regarding claims 10 and 28, Kakivaya-Kotzin discloses the invention substantially as described in claims 1 and 20 above. Kakivaya teaches **initiating a**

second request at the client to discover the server (Kakivaya, Pg. 1, par. [0005]), **wherein the second request is made using a multicast procedure** (Kakivaya, Pg. 1, par. [0005]); **receiving a subsequent response to the second request from the server after a random delay time** (Kakivaya, Pg. 9, par. [0199-0200]; find response is sent after random delay time.).

Kakivaya-Kotzin does not teach **discovering a network disconnect and establishing a second connection with the server**. Harvey teaches **discovering a network disconnect** (Harvey, pg. 8-9, par. [0103]); **and establishing a second connection with the server** (Harvey, pg. 8-9, par. [0103]). Kakivaya-Kotzin and Harvey are analogous art because they are from the same field of endeavor of computer networks. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Harvey's reconnection method with Kakivaya's discovery protocol and Kotzin's establishing a common link with a second device after discovery acknowledgement. The suggestion/motivation would have been to improve the system and method for creating overlay networks (Harvey, pg. 2, par. [0015]).

16. Claims 7-9 and 25-27 are rejected under 35 USC 103(a) as being unpatentable over Kakivaya-Kotzin, as applied to claims 1, 6, 20, and 24 above, and further in view of Rasheed et al 2004/0064574 (Rasheed hereinafter).

Regarding claims 7 and 25, Kakivaya-Kotzin disclose the invention substantially as described in claims 6 and 24 above. Kakivaya-Kotzin does not teach **determining not to connect to the second server**.

Rasheed teaches claim 7, **determining not to connect to the second server** (Rasheed, fig. 1, pg. 2, par. [0020], "...deny the prioritized data transfer session (PDTs) request..."). Kakivaya-Kotzin and Rasheed are analogous art because they are from the same field of endeavor of network communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Rasheed's server connection method with Kakivaya's discovery protocol and Kotzin's establishing a common link with a second device after discovery acknowledgement. The suggestion/motivation would have been to control the quality of data transfer of media between network devices (Rasheed, pg. 2, par. [0015]).

Regarding claims 8 and 26, Kakivaya-Kotzin-Rasheed disclose the invention substantially as described in claims 7 and 25 above, including, **wherein determining not to connect to the second server is based on a characteristic of the server with which the client establishes a connection** (Rasheed, fig. 1, pg. 2, par. [0020], The policy manager may deny the prioritized data transfer session (PDTs) request based on policy rules, i.e. determine not to connect to the server. The PDTs request includes data to specify the determined matching data transmission characteristic and/or matching data transfer protocol, and/or matching media format.).

Regarding claims 9 and 27, Kakivaya-Kotzin-Rasheed disclose the invention substantially as described in claims 7 and 25 above, including **wherein the**

characteristic of the server is a version of the server contained in the response (Rasheed, fig. 1, pg. 2, par. [0020], The policy manager may deny the prioritized data transfer session (PDTS) request based on policy rules, i.e. determine not to connect to the server. The PDTS request includes data to specify the determined matching data transmission characteristic and/or matching data transfer protocol, and/or matching media format. Examiner interprets this characteristic or version to be the type of data transmission characteristic and/or matching data transfer protocol, and/or matching media format of the media server application in fig. 1 matching the request.).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARIQ S. NAJEE-ULLAH whose telephone number is (571)270-5013. The examiner can normally be reached on Monday through Friday 8:30 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

T. N.

/Kenny S Lin/

Primary Examiner, Art Unit 2152